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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,278	09/28/2005	Bob Roeloffs	R0100.0001	1554

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DICKSTEIN SHAPIRO LLP
1633 Broadway
NEW YORK, NY 10019

EXAMINER

VARNUM, RYAN A

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3751

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,278	Applicant(s) ROELOFFS, BOB	
	Examiner RYAN A. VARNUM	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,8,9,11,13,15,16,20,21,23 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) 9,13,15,20,21,23 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,8,11,16 and 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner acknowledges the amendment filed on 3/23/2009. As directed by the amendment: claims 1, 3, 9, 11, 13, 15 and 23 have been amended, claims 2, 4-7, 10, 12, 22, 24 and 25 have been cancelled and claims 33-39 have been added. Thus, claims 1, 3, 8, 9, 11, 13, 15, 16, 20, 21, 23 and 33-39 are presently pending in this application (claims 14, 17-19 and 26-32 having been previously cancelled in the Amendment filed 9/28/2005).

Election/Restrictions

2. Applicant's election with traverse of Species IV (Fig. 9A) in the reply filed on 8/18/2009 is acknowledged. The traversal is on the ground that all the species disclosed have the same or corresponding special technical feature. This traversal is not found to be persuasive.

3. Applicant is correct, in that the restriction of a National Stage application must be made under the "Unity of Invention" standard (See MPEP, 37 CFR 1.475 and 1.499.) Furthermore, Applicant correctly recognizes that the determination of Unity of Invention turns on the finding of a same or corresponding "Special Technical Feature" which each of the inventions and/or species have in common (See *Id.*).

4. The expression "Special Technical Feature" is defined as meaning those technical features that define the contribution which each claimed invention, considered

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as a whole, makes over the prior art (See MPEP, 37 CFR 1.499). Therefore, satisfaction of the unity of invention standard is a two-part analysis requiring: (I) that the multiple inventions and/or species in an application must contain the same or corresponding technical features; and (II) those same or corresponding technical features must read over the prior art.

5. In issuing the previous requirement for restriction and election in this application the Examiner provided a brief explanation specifically describing the unique special technical feature in each of the many species (See Requirement for Restriction/Election issued 7/20/2009, Paragraph 6). It is the Examiner's position that these brief descriptions read side-by-side presented a clear and concise showing that the many species lack a same or corresponding special technical feature as they do not contain the same or corresponding technical features (i.e. – the species Lack Unity of Invention); thereby providing the necessary grounds for requiring a restriction and election between the many species.

6. Applicant now contends that the species of this application all contain the same or corresponding special technical feature; and that such special technical feature is: "the combination of a writing member provided with a writing tip and a clamping device connected to the writing device adapted to clamp the writing member in an edge area of a flat material, and in which the clamping device has first and second elongated legs extending substantially parallel to a facing edge of the writing member, the writing member and the clamping device taking a fixed position relative to each other, ends of the legs being bendably connected to the writing member near the writing tip, and the

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writing tip being situated outside of the area of the clamping device.” The Examiner respectfully disagrees.

7. Without addressing whether the asserted special technical feature is common to each of the many species, as required by the first part of the two-part analysis, the Examiner notes that the asserted special technical feature fails to read over the prior art, as required by the second part of the two-part analysis. As discussed in greater detail below, the series of limitations which Applicant contends is the same or corresponding special technical feature is fully disclosed by Brosius (US Patent 1,840,563). Having failed to read over the prior art, the series of limitations set forth by Applicant does not meet the definition of a special technical feature as recited by MPEP at 37 CFR 1.499.

8. It is the Examiner's conclusion that in the absence of a common special technical feature, the many species disclosed by Applicant fail to satisfy the unity of invention standard. Furthermore, because the search required for the diverse species is not entirely coextensive, inasmuch as the diverse species differ in structure and operation, the patentability of each would likely turn on different grounds. Consequently, the search and examination of the entire application could not be made without serious burden on the Office. Therefore, the requirement is still deemed proper and is therefore made FINAL.

9. Applicant has elected Species IV (Fig. 9A) and has indicated that Claims 1, 3, 8, 11, 15, 16, 20-22 and 33-39 read on Species IV. However, the Examiner notes that:

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claim 22 was previously cancelled (See Amendment filed 3/23/2009); and claim 15 depends from the non-elected claim 13.

10. Also, Claim 20 does not appear to read on Species IV, but instead on Species X (Fig. 12A) and Species XI (Fig. 13A), as discussed in Applicant's specification (Page 10, Lines 17-23) which discloses the clamping engagement being caused by body member 1205.

11. Also, Claim 21 does not appear to read on species IV, but instead on Species XIV (Fig. 16A) and Species XV (Fig. 17A), as discussed in Applicant's specification (Page 9, Lines 6-15) which discloses the a 'click' joint as being an engagement means used to fix the writing member to the clamping device when the clamping device is constructed to receive, or be formed integrally with, a writing member cap, and the writing member being inserted within the area of the clamping device such that the writing tip would likewise be within the area of the clamping device (See Fig.'s 16A-17B).

12. Finally, claim 39 does not appear to read on Species IV, but instead on Species XIV (Fig. 16A), as the limitations of this claim would require that the writing member be closed of by the cap, which is formed integrally with the clamping device, thereby requiring that the tip of the writing member be within the area of the clamping device (See Fig.'s 16A-17B).

13. Accordingly, claims 9, 13, 15, 20, 21, 23, and 39 are withdrawn and claims 1, 3, 8, 11, 16, 33-38 will be examined herein.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

15. Claim 36 is rejected under 35 U.S.C. 112, fourth paragraph, as being an improper dependent claim which fails to further limit the subject matter of a previously set forth claim. The entirety of claim 36 is duplicative of the limitations set forth in the last line of claim 1.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1, 3, 8, 16 and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Brosius (US Patent 1,840,563).
18. In re claims 1 and 36, Brosius discloses a writing device, comprising a writing member 2 (“pencil”; Fig.’s 1-3; Column 1, Line 39) which is provided with a writing tip (“pencil”), and at least a clamping device 1 (“tubular body”; Fig.’s 1-3; Column 1, Line 34) connected to the writing device for clamping the writing member in an edge area of a flat material 9 (“wrist strap”; Fig. 1; Column 2, Lines 67-68), the clamping device

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comprising at least a first elongated leg 4 (“side arms”; Column 1, Line 48) and a second elongated leg 4 (See Fig.’s 1-3) which extend substantially parallel to an edge of the writing member facing thereto (See Fig.’s 1-3), each of the first and second legs having respective first (“U-shaped connecting portion”; Column 2, Lines 66-67) and second ends 5 (“inturned ends”; Fig. 2; Column 1, Lines 49-50), characterized in that the writing member and the clamping device take a fixed position relative to each other (See Fig.’s 1-3) wherein the first leg first end and the second leg first end of the clamping device are bendably connected to the writing member near the writing tip thereof (See Fig. 3; Column 2, Line 65; the “U-shaped portion” bending at the “curved portion 7”) and wherein the writing tip is situated outside of the area of the clamping device (it being understood that the writing member 2 is capable of being inserted backwards with the tip projecting out from the tubular body 1).

19. In re claims 3, 8, 16, 34 and 35, Brosius further discloses 3 (Currently amended). Combination according to claim 1, characterized in that the second end 5 (Fig. 2) of the first leg 4 (Fig. 2) is connected to the second end 5 (Fig. 2) of the second leg 4 (See Fig. 2; the ends 5 being connected to one another by their mutual connection to tubular body 1); the writing member 2 (Fig.’ 1-3) and the clamping device 1 (Fig.’s 1-3) extend substantially in a same plane (See Fig.’s 1-3); the writing member, surfaces thereof, can engage a part of the clamping device for a detachable connection therewith (Column 2, Lines 85-91); and the writing member is provided with a male part of a detachable connection (See Fig.’s 1-3; the shaft of the pencil itself being a “male connection”), and

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the clamping device is provided with a female part of the detachable connection (See Fig.'s 1-3; the cavity of the tubular body 1 is a "female connection").

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 11, 33, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brosius in view of Kim (US Patent 4,302,121).

22. In re claims 11 and 37, although Brosius does not disclose a groove and tongue engagement, attention is directed to Kim which teaches a writing device comprising a writing member 10 ("pen"; Fig. 1; Column 1, Line 58) and a receiving tubular member 20 ("end cap"; Fig.'s 6-8; Column 2, line 43), wherein the writing member over at least a part of the circumference thereof is provided with a groove 13a/13b/13c ("concave surfaces"; Fig.'s 6-8; Column 2, Line 35) for a detachable connection to a tongue part 27a/27b/27c ("convex surfaces; Fig.'s 6-8; Column 2, Line 55) of the receiving tubular member, and the receiving tubular member over at least a part of the circumference thereof is provided with a tongue part 27a/27b/27c (Fig.'s 6-8) for a detachable connection to a groove of the writing member 13a/13b/13c (Fig.'s 6-8), for the purpose of providing a writing member with an ergonomic gripping surface which also facilitates

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reception of the writing member into a receiving member (Fig.'s 6-8; Column 1, Lines 17-21).

23. Accordingly, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to modify the device of Brosius, such that the writing member comprised a groove structure and the clamping device comprised a mating tongue structure, as taught by Kim, for the purpose of providing the writing member of Brosius with an ergonomic gripping surface while also providing the tubular body of Brosius with a mating configuration for facilitating receipt of the modified surface of the writing member therein.

24. In re Claims 33 and 38; Kim further discloses the receiving tubular member 20 (Fig.'s 6-8) over at least a part of the circumference thereof is provided with a groove (See Fig.'s 6-8; the grooves being the cavities in the outer surface of cap 20 which receive the corners 17 of the writing member 10) for a detachable connection to a tongue 17 ("corners"; Fig.'s 6-8; Column 2, Line 3) part of the writing member, and the writing member 10 (Fig.'s 6-8) over at least a part of the circumference thereof is provided with a tongue part 17 (Fig.'s 6-8) for a detachable connection to a groove of the receiving tubular member (Fig.'s 6-8). It being understood that upon modifying the device of Brosius in view of Kim, as discussed above with regard to Claims 11 and 37, these further structures would likewise be incorporated into the writing member 2 and tubular body 1 of Brosius.

25. Response to Arguments

25. Applicant's arguments filed on 03/23/2009 with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN A. VARNUM whose telephone number is (571) 270-7853. The examiner can normally be reached on Monday - Friday, 9:00 AM - 5:00 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. A. V./
Examiner, Art Unit 3751

/Huyen Le/
Primary Examiner, Art Unit 3751